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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/828,261	04/21/2004	Shuji Hirakata	119506	4840
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EXAMINER				
WANG, EUGENIA				
ART UNIT		PAPER NUMBER		
1795				
MAIL DATE		DELIVERY MODE		
07/18/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/828,261

Applicant(s)

HIRAKATA ET AL.

Examiner

EUGENIA WANG

Art Unit

1795

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. In response to the amendment received June 3, 2008:
 - a. Claims 16-19 have been added as per Applicant's request. Claims 1-19 are pending.
 - b. The previous 112 rejection has been withdrawn in light of the amendment. However, a new, similar 112 rejection is made in light of the amendment.
 - c. The previous rejections of record have been withdrawn in light of the amendment. However many 112 issues have been brought to light by the amendment, such that Examiner cannot ascertain the invention to apply prior art. Therefore, all of the claims are still rejected, and thus the action is final.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

d. Claims 1, 4, and 11 recite that the temperature-maintenance operation controller is configured to execute while the ignition key is in an off position. However, there is not support for this in the written disclosure. Page 8, paragraph 0027 in the Specification mentions that a switch is used to turn the fuel cell system on and off, this does not necessarily equate to a teaching wherein the switch is the key in the ignition. (For example, the switch in such an automobile may be using the break pedal which moves the switch on and off to indicate startup or shutdown. Furthermore, the switch that indicates the starting of the vehicle system does not equate to the fact that the fuel cell system is started at that moment, as perhaps a certain driving condition must be met before the fuel cell portion is activated. Accordingly, the specification does not clearly teach the claim language, and thus it is viewed as new matter.) Accordingly, claims 1, 4, and 11 cite new matter, and since claims 2, 3, 5-10, and 12-19 are dependent on either claims 1, 4, or 11, they are rejected for the same reason.

e. Claims 1, 4, and 11 recite that the fuel cell "partially" restarts (lines 11, 16, and 6, respectively). However, examiner submits that the fuel cell is fully restarted, as the fuel cell is generating power (see the Specification, page 9, lines 10-11). Accordingly, since the fuel cell is operating, it has fully restarted. (A partial starting would constitute flowing one reactant but not the other.) Accordingly, claims 1, 4, and 11 cite new matter, and since claims 2, 3, 5-10, and

12-19 are dependent on either claims 1, 4, or 11, they are rejected for the same reason.

3. Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

f. Claims 1, 4, and 11 recite that the fuel cell system comprises of a temperature detector and a temperature-operation controller. However, the claim also states that the fuel cell system is not operating, but the temperature-maintenance controller is operating. Such claim language is contradictory, since the temperature-maintenance operation controller (part of the fuel cell system, as claimed) is operating when the fuel cell system is claimed to not be operating. Therefore this is indefinite, as Examiner is unsure how a portion of the fuel cell system is operating, wherein the system, as claimed is not operating. Since claims 2, 3, 5-10, and 12-19 are dependent on either claims 1, 4, or 11, they are rejected for the same reason.

g. Claims 1, 4, and 11 recite that the fuel cell "partially" restarts (lines 11, 16, and 6, respectively). However, the claim language is indefinite, as it is uncertain as to what is meant by a partial restarting. Additionally, the Specification (page 9, lines 10-11) seems to indicate that a full restart has taken place, since the fuel cell is generating power. However, in light of the Specification, Examiner submits that perhaps Applicant meant that the fuel cell was restarted at a lower power output or a lower load demand. However, as claimed, an incorrect mean has

been applied to the word "partially." Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term "partially" in claims 1, 4, and 11 is used by the claims to mean "at a lower value" (as indicated by the Specification, p9, lines 10-11), while the accepted meaning is "in part." The term is indefinite because the specification does not clearly redefine the term. Accordingly, the claim language is indefinite, and since claims 2, 3, 5-10, and 12-19 are dependent on either claims 1, 4, or 11, they are rejected for the same reason.

Response to Arguments

4. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Examiner would like to take a moment to address the 112 rejection, as Applicant submits that the amendment has corrected the indefinite claim language.

Examiner respectfully disagrees. It is submitted that Applicant has missed the meat of the rejection. As stated in section 3f, the indefiniteness is drawn to the claim language that the temperature-maintenance operation control (a part of the fuel cell system) is operating, wherein the fuel cell system is not running. Since the control is

part of the system, if the system is not running, it should not be running either. Therefore, Examiner upholds that indefiniteness with respect to this aspect still exists.

Conclusion

5. It is noted that in light of the numerous 112 issues, the previous prior art rejection has been withdrawn. This, however, is not an admission that the previous prior art is no longer applicable. The application of the previous prior art may be reapplied upon clarification of the claim language. Although no prior art rejection has been applied, this is not an admittance of allowable subject matter. Any changes to the claims would change the scope of the claims and require further consideration at that point. Additionally, with respect to the 112(1) rejection, if Applicant submits that no new matter has been added, Examiner respectfully requests that Applicant provide references to the specification for each claim limitation.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EUGENIA WANG whose telephone number is (571)272-4942. The examiner can normally be reached on 7 - 4:30 Mon. - Thurs., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/E. W./
Examiner, Art Unit 1795

/PATRICK RYAN/
Supervisory Patent Examiner, Art Unit 1795